

REMARKS

In the Office Action dated August 2, 2004, claims 1, 2, 4-6, 8, 9, 11 and 12 were rejected under 35 U.S.C. § 102(b) as allegedly anticipated by U.S. Patent No. 5,732,328 to Mitra et al. (hereinafter "Mitra"). Claims 3, 7, 10 and 13 were also rejected under 35 U.S.C. § 103(a) as allegedly obvious over Mitra in view of U.S. Patent No. 6,542,488 to Walton et al. (hereinafter "Walton").

By the foregoing amendment, claims 1, 6, 8 and 12 are amended to clarify the claimed subject matter, and claims 4 and 11 are canceled without prejudice. Applicants respectfully submit that the claims as amended are patentable over the cited prior art.

Rejections under 35 U.S.C. § 102(b)

Claims 1, 2, 4-6, 8, 9, 11 and 12 were rejected under 35 U.S.C. § 102(b) as allegedly anticipated by Mitra. Applicants respectfully traverse these rejections.

The present application includes independent claims 1, 6 and 8. Independent claim 1 as amended is directed to a method for controlling transmitter power level of a mobile unit, comprising, *inter alia*,:

transmitting from an access point to said mobile unit data representing transmitter power level for said access point;

receiving at said mobile unit said access point transmitter power level data; and

adjusting transmitter power level of said mobile unit in accordance with the value of said access point transmitter power level data

wherein said access point transmitter power level data is transmitted as part of said beacon signal.

Independent claims 6 and 8 recite similar limitations in some respects.

Mitra is directed to a method for setting transmission power of a wireless terminal for transmitting a signal representing information of a particular information class to a base station capable of receiving signals for a plurality of information classes. (See Mitra, col. 3, lines 4-8). In particular, the transmission power is set such that the corresponding received signal strength would have a probability of signal outage durations over a time interval that are tolerable for the particular information class represented in the signal. (See Mitra, col. 3, lines 8-12). The transmission power determination according to the method of Mitra relies on a probability measure based on a mean or average value of detected signal interference as well as a variation of such interference from the mean over a time interval. (See Mitra, col. 3, lines 31-35).

In the Office Action, the Examiner submits that “Mitra et al. disclose said access point transmitter power level data is transmitted as part of said beacon signal (see col. 9, liners 64-65).” (Office Action, p. 3). Applicants respectfully disagree with the Examiner in this respect. The cited portion of Mitra, cited more completely, is as follows:

In accordance with the method 300, the base station 5 transmits a beacon signal at a known power in step 310. It is desirable for the beacon signal to be transmitted on a particular channel not used for uplink and downlink communications so as not to interfere with such communications. The beacon signal is received by the wireless terminal 21 for which communication is to be established or maintained. The wireless terminal 21 *detects the received signal strength of the beacon signal and transmits a signal back to the base station 5 indicating the received signal strength.*” (emphasis added).
Mitra col. 9, ln. 64 - col 10, ln. 7.

As is described in the cited portion of Mitra, the signal strength of the beacon is sensed, and then a second signal is transmitted to a base station which indicates the signal strength. This is distinct from the recited limitation of the claimed invention, which requires that the access point transmitter power level data is transmitted as part of said beacon signal. Accordingly, for at least this reason, Mitra fails to disclose or suggest all limitations of the claims, and therefore cannot

anticipate claim 1. Claims 6 and 8 are amended to recite a similar limitation. Accordingly, Applicants respectfully submit that claims 1, 6 and 8 as amended are in condition for allowance. Furthermore, because all remaining pending claims include these same limitations through dependency from claims 1, 6 and 8, Applicants respectfully submit that all claims are in condition for allowance, for at least the reasons set forth above.

Rejections under 35 U.S.C. § 103(a)

Claims 3, 7, 10 and 13 were rejected under 35 U.S.C. § 103(a) as allegedly obvious over Mitra view of Walton. Applicant respectfully traverses these rejections.

First and foremost, Applicant submits that the combination of the references which form the basis of the § 103 rejections is improper. The Examiner's only stated basis for combination of the references is that "it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the system of Mitra et al. with the above teaching of Walton et al. in order to quick channel access without waiting for power control packet sending from base station." Office Action, p. 4. However, Applicant submits that this is *not* a proper basis for combination of references under § 103. As the Court of Appeals for the Federal Circuit has held:

It has not been shown that a person of ordinary skill, seeking to solve a problem of fastening a hose clamp, would reasonably be expected or motivated to look to fasteners for garments. The combination of elements from non-analogous sources, in a manner that reconstructs the applicant's invention only with the benefit of hindsight, is insufficient to present a *prima facie* case of obviousness. There must be some reason, suggestion, or motivation found in the prior art whereby a person of ordinary skill in the field of the invention would make the combination. That knowledge can not come from the applicant's invention itself.

In re Oetiker, 24, U.S.P.Q.2d 1443, 1447, 977 F.2d 1443, 1447 (Fed. Cir. 1992).

There is no "reason, suggestion, or motivation" in the prior art such that one of ordinary skill in the art would make the combination of Mitra and Walton which forms the basis of the

rejections under 35 U.S.C. § 103(a) in the Office Action. Even if Mitra and Walton can be considered to be analogous art, the Federal Circuit has held that the mere fact that a prior art device *could* be modified so as to produce the claimed device is not a basis for an obviousness rejection unless the prior art suggested the desirability of such a modification. See, e.g., *In re Gordon*, 221 U.S.P.Q. 1125, 733 F.2d 900 (Fed. Cir 1984). No such suggestion appears in either Mitra or Walton, and the Examiner has not even asserted that such a suggestion is found anywhere in these references or elsewhere in any prior art.

Accordingly, because there is no teaching or suggestion towards the cited combination in the prior art, in conformity with the law as recited by the Federal Circuit, these references are not properly combined. Applicant therefore respectfully submits that the rejections of claims 3, 7, 10 and 13 under 35 U.S.C. § 103(a) are improper for at least this reason, and submits that these claims are in condition for allowance.

Even assuming *arguendo* that Mitra and Walton are properly combined, the combination of reference still fails to disclose or suggest one or more limitations of claims 3, 7, 10 and 13. In particular, as discussed at length, above, applicant respectfully submits that the references in combination fail to disclose or suggest a system or method in which the power level data is transmitted as part of a beacon signal. For at least this additional reason, Applicants respectfully submit that the claims as amended are in condition for allowance.

CONCLUSION

In view of the foregoing remarks, favorable reconsideration and allowance of claims 1-3, 5-10 and 12-13 as amended are respectfully solicited. In the event that the application is not deemed in condition for allowance, the examiner is invited to contact the undersigned in an effort to advance the prosecution of this application.

Respectfully submitted,



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